

REMARKS

This amendment is responsive to the Office Action of September 16, 1998. A request for a three-month extension of time and the appropriate fee are enclosed.

1. Affirmation of Election

Applicants hereby affirm the provisional election made during the March 19, 1998 phone conference between Examiner Cameron and Applicants' attorney Bob Strauss, to prosecute the invention of Group 1 and species a), c) and m), claims 1-2, 5, 7, 8, 15-17 and 20

2. Section 112, Second Paragraph Rejections

The Office Action rejects Claims 1-2, 5, 7, 8, 15-17 and 20 under 35 U.S.C. 112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

A. Meaning of "Enhancement" or "Enhanced."

The Office Action is concerned about the meaning of "enhancement," posing the question, "Enhancement over What?"

Applicants respectfully submit that the Claims are clear, and in compliance with Section 112, in that they do not simply relate to "enhancement," but rather specifically relate to decorative enhancement. In particular, Claim 1 is directed to "[a] method for permanent *decorative enhancement* of a polyethylene surface of a molded polyethylene

article,” and Claim 1 further recites “a *decorative enhancement* composition.” In further explanation, the specification speaks to a decorative enhancement composition involving a colorant (see e.g. page 2, lines 14-34). In short, the polyethylene surface is decoratively enhanced relative to a non-decorated surface and, as clear from the specification, the color of some part of that surface is altered from what it would be in the absence of the decorative enhancement.

Applicants respectfully submit that the claims do particularly point out and distinctly claim the invention with regard to Applicants’ usage of the phrase “decorative enhancement.”

B. Binder Solids of Claim 1

The Office Action states that the binder solids specified in Claim 1 appear to overlap, that petroleum does not appear to be a solid, and that where synthetic and emulsifiable waxes appear to be required together.

Applicants have amended Claim 1 to recite a “binder” rather than a “binder *solid*” to resolve the solid versus non-solid issue with regard to petroleum. Applicant respectfully notes that the original specification speaks to the use of “a binder” (e.g. page 2, lines 23).

Applicants have further amended the specified group of binders (no longer part of Claim 1, but now set forth in dependent Claim 45) such that synthetic and emulsifiable waxes semantically appear as alternatives.

C. Antecedents

Applicants have carefully amended Claim 1 to resolve the lack of antecedents identified by the Examiner. In particular, Applicants have amended “said *deposited* decorative enhancement composition” to “said decorative enhancement composition” and has deleted said “interfacing surface” altogether.

The Examiner is thanked for the careful review given to the claims.

D. “Elevated Temperature”

The Office Action states that “elevated temperature” is vague. In response, Applicants have amended Claim 1 to remove the specified language and to require the heating of the composition and the polyethylene article to produce a polyethylene article having a colorant on and in the polyethylene surface.

E. Claim 5

Applicants have amended Claim 5 to place it in proper Markush form as requested by the Examiner.

3. Section 112, First Paragraph Rejections

The Office Action rejects Claims 1-2, 5, 7, 8, 15-17 and 20 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention.

A. Abstract – Last Two Lines

Applicant has amended the abstract to state that the mixture of binder, particulate thermoplastic powder and colorant are “mixed with liquid carrier, wherein the liquid carrier comprises 20 to 90 weight percent [liquid carrier] of the overall decorative enhancement composition.”

B. The Specification and Figure 6

Applicant has amended the specification to conform with the reference number of Figure 6 as follows:

FIGURE 6 illustrates the application of heat to the coating [16] 12 of the decorative enhancement composition prepared as shown in FIGURE 5. The heat treatment is the same as that described with respect to FIGURE 4.

Page 10, lines 3-6 (as amended)

C. Agreement Between the Abstract and the Claims

Applicant has amended the abstract (p.17) to correctly specify the preferred weight ratio of binder to thermoplastic powder as “30 to 70 percent,” as claimed and as stated elsewhere in the specification (e.g. page 4, lines 28-33).

Based on the above amendments, Applicants respectfully submit that the Claims are in fully compliance with Section 112.

4. Section 103 – WO 96/23041

The Office Action rejects Claims 1-2, 5, 7, 8, 15-17 and 20 as obvious over WO 96/23041. The WO 96/23041 reference was published on August 1, 1996, more than one year before this application was filed (August 17, 1997). Applicants have amended the specification to claim the priority to co-pending application no. 566,906, which application was filed on December 4, 1995¹, prior to the August 1, 1996 publication date of WO 96/23041. Applicants have also carefully amended Claim 1 in order to claim priority and recite patentable subject matter. Finally, Applicants have also added new dependent Claims 39-46 to more specifically recite the requirements of Applicants' preferred embodiment.

Applicants respectfully submit that Claims 1-2, 5, 7, 8, 15-17, 20, and 39-46 are now in condition for allowance in that WO 96/23041 is no longer applicable as a prior art reference and the claims recite allowable subject matter.

¹ The priority application issued on May 5, 1998 as U.S. Patent No. 5,746,961.


5. Summary

Based on the above amendments and accompanying remarks, Applicants submit that this entire case is in condition for allowance and earnestly solicit a notice to that effect. The Examiner is invited to call the undersigned attorney if it appears that a phone conference would further this case in any way.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on

March 16, 1999

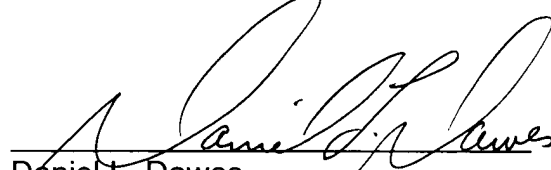
by Eric Hoover



Signature

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Respectfully submitted,



Daniel L. Dawes

Registration No. 27,123

Myers, Dawes & Andras LLP

650 Town Center Drive, Suite 650

Costa Mesa, CA 92626

(714) 444-1199